

REMARKS

Reconsideration and allowance of this application are respectfully requested in light of the foregoing amendments and the following remarks.

Claim Status

Claims 1-8 were presented in the originally filed application. New claims 9-14 were added. Claims 2-3 and 8-13 are cancelled. Claims 1, 4-7 and 14 are pending. No new matter was added.

§112 Rejection

Claims 1, 4-7 and 14 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written restriction requirement. Applicant traverses.

The Examiner has maintained that Applicant must provide the raw data of the X-ray powder diffraction spectrum of δ crystalline form of perinodopril erbumine, in order to demonstrate that Applicant was in possession of the instant invention. In response to the Examiner's requirement, Applicant is submitting the requested X-ray diffraction spectrum (See Attachment). Looking to M.P.E.P. 2163 it states:

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by "whatever characteristics sufficiently distinguish it").

Clearly, the language contained in the specification of the instant invention, along with the X-ray diffraction spectrum attached hereto, describes all of the experimental conditions used for obtaining the X-ray diffraction data on which claims 1, 4-7 and 14 are based in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In light of the arguments presented above and the amendments to the claims, Applicant respectfully requests that the rejection of claims 1, 4-7 and 14 be removed and the claims allowed.

Reconsideration and allowance of this application is  
respectfully requested.

Respectfully submitted,

  
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